

## **Remarks**

As stated above, Applicants appreciate the Examiner's thorough examination of the subject application and request reexamination and reconsideration of the subject application in view of the preceding amendments and the following remarks.

As of the office action of Sep. 1, 2009, claims 2 and 8-10 were pending in the subject application. With this response applicant has amended claims 2 and 8-10

### **A. Summary of the Office Action**

- (i) The Office rejected claims 2 and 8-10 under 35 U.S.C. § 112, first paragraph. (Office Action at p. 2).
- (ii) The Office rejected claim 2 under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,943,053 ("Ludolph"). (Office Action at p. 3).
- (iii) The Office rejected claims 8-9 under 35 U.S.C. § 103 as unpatentable over Ludolph. (Office Action at p. 4).
- (iv) The Office rejected claim 10 under 35 U.S.C. § 103 as unpatentable over Ludolph in view of U.S. Patent No. 7,065,785 ("Shaffer"). (Office Action at p. 6).

### **B. Rejections Under 35 U.S.C. § 112**

The Examiner rejected claims 2, 8-10 under 35 U.S.C. § 112, first paragraph, alleging that the claimed limitation of "without resizing said side bar" is not enabled. (Office Action at p. 2). The Examiner also stated that the feature is "critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." (Id.). The Examiner also states the term "without resizing said side bar" is not clearly defined in the specification. (Id.).

Applicant is unsure whether the Examiner is rejecting the claim based on unclaimed essential matter (See M.P.E.P. § 2172.01), or based on a specification that does not clearly define the term in the specification (See M.P.E.P. § 706.03(c)). The Office Action suggests that the rejection is based on unclaimed essential matter. (Office Action at p. 2). However, the term "without resizing said side bar," which was cited by the examiner as the basis for the unclaimed essential matter rejection, appears in the claims. Applicant therefore contends that a rejection based on unclaimed essential subject matter is not sustainable and requests withdrawal of the § 112 rejection of claims 2 and 8-10.

However, the Office Action also suggests the rejection is based on a lack of description of the term "without resizing said side bar" in the specification. Applicant contends that the rejections are inconsistent with each other. If the term or concept is essential material, it generally is described in the specification but not included in the claims. (See M.P.E.P. § 2172.01). However, if a term or concept lacks description in the specification, it generally appears in the claims but is not described in the specification. (See M.P.E.P. § 706.03(c)). Applicant does not understand how a term or concept can be both essential material in the specification and not described in the specification. Applicants respectfully request clarification of the rejection.

Furthermore, even if the term "without resizing said side bar" is not described in the specification, as the Examiner suggests, Applicants contend that the term "without resizing said side bar" is enabled. "[T]he fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled." (M.P.E.P. § 2164). "In other words, the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure." (Id.). Applicants contend

that the term "without resizing said side bar" is enabled because a person of ordinary skill in the art who is practicing the claimed invention would understand the term, and would be able to make and use the invention, including the limitation of "without resizing said side bar."

Applicants are unclear whether the Examiner's rejection calls for removal or inclusion of the term "without resizing said side bar" in the claims. If the rejection is based on unclaimed essential matter, the rejection suggests that the term must be included in the claims. (See M.P.E.P. § 2172.01). However, if the rejection is based on lack of written description or lack of enablement, and if the specification does not describe the term as the Examiner suggests, then the rejection suggests that the term should be removed from the claims. Applicant requests clarification of the rejection in order to respond appropriately. For the purposes of this response, Applicants have removed the term from the claim.

### **C. Rejections Under 35 U.S.C. § 102**

The Examiner rejected claim 2 under § 102 over Ludolph. (Office Action at p. 3). Applicants respectfully traverse the rejection. Ludolph does not appear to teach or suggest a sliding animation as described in the specification and claimed in claim 2. The Examiner relies on the phrase "transitional animation" in Ludolph. (Office Action at p. 10). The Examiner appears to suggest that, because Ludolph uses the term "transitional animation," any animation is anticipated by Ludolph. (Office Action at p. 10). Applicants maintain, however, that Ludolph's transitional animation does not disclose a sliding animation as claimed, but rather discloses an animation that enlarges and contracts a window. (See Response filed May 19, 2009). Applicants contend that Ludolph does not appear to disclose any type of sliding animation. For example, Ludolph's use of the term "transition animation" to describe enlarging and contracting a window does not appear to teach or suggest a sliding animation because the sliding animation, as

described in the claims and specification, is different from enlarging and contracting a window as disclosed by Ludolph. (See Id.).

Further, Ludolph's use of the term "transitional animation" does not appear to disclose a genus that encompasses every transitional animation because Ludolph uses the term specifically to describe enlarging and contracting a window. (See e.g. Ludolph at col. 9 lines 54-61). Even if the term "transitional animation" were a genus, Ludolph does not appear to describe or disclose the species of a *sliding* animation. (See generally Id.).

However, for the purpose of furthering prosecution, Applicants have amended the claims to further clarify the sliding animation. Claim 2, as amended, recites in part:

wherein said first slide animation and said second slide animation comprise moving said page associated material into or out of said side bar via one or more of: an up, down, left, right, or looping motion [.]

The other claims contain similar amendments and will be discussed collectively. Applicants contend that no new matter has been added with this amendment because the subject matter appears in the application as originally filed. (See Subject Application at ¶ 200).

Applicants contend that Ludolph does not disclose "wherein said first slide animation and said second slide animation comprise moving said page associated material into or out of said side bar via one or more of: an up, down, left, right, or looping motion[.]" As discussed, Ludolph mentions a transitional animation, and specifically describes the transitional animation as expanding and/or contracting the size of a window. (E.g. Ludolph at col. 9 lines 54-61). Ludolph does not, however, appear to disclose or suggest a sliding animation. Nor does Ludolph appear to disclose or suggest "moving said page associated material into or out of said side bar via one or more of: an up, down, left, right, or looping motion[.]" as claimed. Indeed, Ludolph does not appear to mention moving material into or out of a side bar at all. Rather, Ludolph

appears to discuss expanding or contracting the size of a window. (Id.). Therefore, Applicants contend that claim 2 is patentable under § 102 over Ludolph since Ludolph does not appear to disclose each and every element of claim 2. Accordingly, Applicants request withdrawal of the § 102 rejection of claim 2.

#### **D. Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 8-9 under 35 U.S.C. § 103 as unpatentable over Ludolph. (Office Action at p. 4). The Examiner argues that Ludolph discloses each element of claims 8-9, but does not disclose an hierarchy of rooms. (Id. at p. 6). The Examiner also takes official notice that an "hierarchy of windows" is well known in the art. (Id.). Applicants respectfully disagree. First, the claims recite an "hierarchy of rooms," not an "hierarchy of windows." Therefore, even if an "hierarchy of windows" is obvious, as the Examiner suggests, it would not necessarily render an "hierarchy of rooms" obvious because the specification does not appear to use the term "rooms" and "windows" synonymously. (See e.g. Subject Application at ¶ 193).

Second, Applicants contend that an "hierarchy of windows" is not common knowledge, and therefore official notice is inappropriate. Official notice unsupported by documentary evidence in a final rejection must rely on common knowledge in the art that is capable of instant and unquestionable demonstration of being well known:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust

intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it").

Applicants contend that an "hierarchy of windows" is not common knowledge in the art that is capable of instant and unquestionable demonstration of being well known because an "hierarchy of windows" is not common and ubiquitous in the art. Indeed, Webster's New World Computer Dictionary and the Microsoft Computer Dictionary do not recognize the term and do not contain entries for an "hierarchy of windows." (Bryan Pfaffenberger, WEBSTER'S NEW WORLD COMPUTER DICTIONARY 230-31, (Wiley Publications, 2002); MICROSOFT COMPUTER DICTIONARY 336 (Sandra Haynes ed., Microsoft Press, 5th ed. 2002)). Therefore, Applicants contend that the Examiner's use of official notice cannot support the rejection under § 103.

Third, as discussed above, Applicants have amended claims 8-9 to recite, in part:

wherein said first slide animation and said second slide animation comprise moving said side bar material into or out of said side bar via one or more of: an up, down, left, right, or looping motion [.]

As noted, Ludolph does not appear to disclose the amended element or the sliding animation of claims 8-9 and therefore does not disclose or suggest each and every element of the claims. Accordingly, for the reasons discussed above, Applicant requests withdrawal of the § 103 rejection of claims 8-9.

The Examiner also rejected claim 10 under 35 U.S.C. § 103 as unpatentable over Ludolph in view of U.S. Patent No. 7,065,785 ("Shaffer"). (Office Action at p. 6). The arguments above, advanced in support of claims 8-9, also apply to claim 10. Specifically and as discussed above, Applicants contend that, like claims 8-9, claim 10 is patentable under § 103 because a) the Examiner equates a "hierarchy of rooms" with a "hierarchy of windows" where

rooms and windows appear to be separate concepts, b) the Examiner's use of official notice is improper because a "hierarchy of windows" is not instantly recognizable in the art, and c) Ludolph does not appear to disclose each and every element of the claims. Further, Shaffer does not appear to remedy Ludolph's deficiencies. As the functionality of claim 10 similarly recites the limitation of slide animations, Applicants respectfully submit that the further consideration of Shaffer fails to remedy (and is not even asserted to remedy) the deficiencies of the primary reference. Accordingly, Applicants respectfully assert that claim 10 is non-obvious over the combined teachings of Ludolph and Shaffer. As such, withdrawal of the § 103 rejection of claim 10 is respectfully requested.

#### **E. Conclusion**

In consideration of the amendments and foregoing discussion, the application is now believed to be in condition for allowance. Early allowance of the subject application is respectfully solicited. The Examiner is invited to contact Applicants' agent at 617-305-2136 to facilitate prosecution.

This response is not believed to necessitate any additional fees. However, in the event that additional fees are due, please charge or credit any refund to our Deposit Account No. 50-2324.

Respectfully Submitted,

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